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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|----------------------|------------------|
| 09/933,101 | 08/20/2001 | Claude Lambert | 159.I.334 A | 7127 |
| 7590 | 07/07/2004 | | EXAMINER | |
| WATOV & KIPNES, P.C. P.O. Box 247 Princeton Junction, NJ 08550 | | | CARTER, MONICA SMITH | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3722 | |

DATE MAILED: 07/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) |
|------------------------------|------------------------|---------------------|
| | 09/933,101 | LAMBERT ET AL. |
| | Examiner | Art Unit |
| | Monica S. Carter | 3722 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 24 June 2004.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-39 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) Claim(s) _____ is/are allowed.
6) Claim(s) 1-39 is/are rejected.
7) Claim(s) _____ is/are objected to.
8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ .
5) Notice of Informal Patent Application (PTO-152)
6) Other: _____

DETAILED ACTION

Request for Continued Examination

1. The request filed on June 24, 2004 for a Request for Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 09/933,101 is acceptable and an RCE has been established. An action on the RCE follows.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Royer ('991) in view of Ehrhart et al. ('157).

Royer discloses a document (20) comprising a substrate; a play area comprising an encoded game data portion (22) on the substrate; a non-game data region (area other than game data portion on surface 24) and at least one scratch-off layer (26) over the encoded game data portion.

Royer discloses the claimed invention except for the specific arrangement and/or content of indicia ("an encoded game data portion comprising a plurality of icons defining a game data region and an area defining a non-game data region") set forth in the claim(s). It would have been obvious to one having ordinary skill in the art at the

time the invention was made to encode the game data portion (e.g., the barcode 22 of Royer) with any required information since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of encoded game data portion does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter and the substrate which is required for patentability.

Royer discloses the claimed invention except for the particular layers of the encoded game data portion as claimed.

Ehrhart et al. disclose methods for processing security documents comprising a game ticket (202) having a first indicia icon layer (226) forming the indicia patterns (223) covered by scratch-off material and a second translucent, printable varnish layer (238 – release layer); wherein both layers are located beneath the scratch-off material (211) (as seen in figure 2-5 and col. 7, lines 5-15). The first and second layers together define a game data region (226) and a non-game data region (228) with the game data region comprising an encoded pattern of symbols (223). The first and second layers are constructed of different materials (as evidenced by the lines of element 226 and the

omission of lines of element 228) and would, therefore, exhibit, different reflectance values. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Royer's invention by providing the encoded game data portion with two different layers having two different reflectance values, as taught by Ehrhart, to enhance the security of the document deterring the possibility of forgery.

Regarding claims 2, 5, 7, 18, 20, 22 and 27, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a desired value for the reflectance (e.g. the value of the second reflectance less than the value of the first reflectance), since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F. 2d 272, 205 USPQ 215 (CCPA 1980).

Regarding claim 3, Royer, as modified by Ehrhart et al., disclose that various colors and shades of colors are seen in white light when illuminated by a narrow band of illumination source (red light - see col. 12, lines 17-20 and 59-63).

Regarding claims 4, 6, 19 and 21, it would have been obvious to one having ordinary skill in the art at the time of the invention to provide any desired range for the reflectance value, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Regarding claims 8 and 9, Royer, as modified by Ehrhart et al., disclose the encoded pattern of symbols being present in the game data region and the non-game data region (as seen in figures 2-4 of Royer and col. 7, lines 5-10 of Ehrhart et al.).

Regarding claim 10, Royer, as modified by Ehrhart et al., disclose the encoded pattern of symbols appearing in less than the entire game data region or non-game data region (as seen in figure 3 of Royer and figure 2-5 of Ehrhart et al.).

Regarding claim 11, it would have been obvious to locate the encoded pattern of symbols in any desired arrangement, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70. Furthermore, applicant has failed to disclose that the location of the encoded pattern of symbols is critical to the invention.

Regarding claims 14-17, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a second encoded pattern, a second layer with non-game data, at least one additional layer printed over the at least one scratch-off layer, since it has been held that mere duplication of essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Regarding claim 28, the document is a lottery ticket (see Royer col. 2, lines 13-15).

Regarding claim 29-39, the method of detecting tampering of a document and producing a tamper resistant document is inherently disclosed in the above rejections.

Response to Arguments

4. Applicant's arguments filed May 6, 2004 have been fully considered but they are not persuasive.

Applicant argues that Royer fails to disclose the "encoded game data portion" as defined. Applicant defines the "encoded game data portion" including a game data region and a non-game data region having a series of symbols in a form of a detectable pattern which can be read and analyzed by a validating machine, typically employing an optical detection system. The examiner disagrees and continues to maintain that Royer discloses an encoded game data portion 22 (bar code) printed on the substrate, wherein the encoded game data portion is in the form of a series of symbols in the form of a detectable pattern which can be read and analyzed by a bar code scanner and validating machine, since the intent of the invention is to scan the bar codes to authenticate the printed document (lottery ticket). Regarding the particular information to be encoded in the encoded game data portion, one of ordinary skill in the art would have found it obvious to provide any information encoded in the bar code of Royer depending on the information to be displayed and the end result desired. The bar code of Royer is capable of being encoded such that it includes a game data region and a non-game data region. Therefore, the examiner maintains the Royer does disclose the encoded game data portion as defined in the present application.

Applicant argues that Ehrhart et al. fail to teach or suggest the "encoded game data portion" as defined. Applicant defines the "encoded game data portion" including a game data region and a non-game data region having a series of symbols in a form of a

detectable pattern which can be read and analyzed by a validating machine, typically employing an optical detection system. The examiner maintains that, as set forth above, it would have been obvious to encode the encoded game data portion with any information depending on the end result desired. It is noted that Ehrhart et al. is used for teaching the reflectance values of the various layers of the document and has not been relied upon for disclosing the encoded game data portion having a game data region and a non-game data region.

For the reasons as set forth above, the rejections are maintained.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica S. Carter whose telephone number is (703) 305-0305. The examiner can normally be reached on Monday-Thursday (6:30 AM - 4:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea L. Wellington can be reached on (703) 308-2159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

July 6, 2004

Monica S. Carter
MONICA S. CARTER
PRIMARY EXAMINER